



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
29250-001082/US

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Application Number
10/681,287Filed
October 9, 2003First Named Inventor
Krishna BALACHANDRAN et al.Art Unit
2617Examiner
Dung Le Lam

On _____

Signature _____

Typed or printed name _____

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Reasons For Pre-Appeal Brief Request For Review attached

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 60,977.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Ryan E. Alley

Typed or printed name

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Telephone number

May 7, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/681,287 Art Unit: 2617
Filing Date: October 9, 2003 Examiner: Lam, Dung Le
Applicant: Krishna BALACHANDRAN et al. Conf: 9239
Title: METHODS FOR TRIGGERING REGISTRATION TO A
WIRELESS NETWORK AND PAGING THEREFROM
Attorney Docket: 29250-001082/US

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May 7, 2009

REASONS FOR REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

In response to the Office Action mailed on January 7, 2009 ("Office Action"), Applicants request that the Pre-Appeal Brief Review Board (hereinafter Board) review the pending rejections. The Reasons for Pre-Appeal Brief Request for Review are being filed concurrently with the Pre-Appeal Brief Request for Review and a Notice of Appeal.

Claims 1-5 and 7-13 are pending in the current Application, and claims 1-5 and 7-13 stand rejected. Claims 1, 5 and 10 are independent claims.

Rejections For Which Conference Is Requested

A Pre-Appeal Brief Conference is respectfully requested to review the rejection to claims 1-5 and 7-13 as being anticipated by US Pub 2003/0114177 to Sinnarajah ("Sinnarajah"), and the rejection to claim 1 as being anticipated by US Pat 7,451,475 to Oz ("Oz").

I. SINNARAJA DOES NOT DISCLOSE "NOT TRIGGERING GENERATION OF A REGISTRATION MESSAGE WHEN FLOW OR FREQUENCY ALONE CHANGE" RECITED IN CLAIM 1.

SINNARAJA DOES NOT DISCLOSE A "REGISTRATION MESSAGE IS NOT GENERATED WHEN FLOW OR FREQUENCY ALONE CHANGE" RECITED IN CLAIM 5.

SINNARAJA DOES NOT DISCLOSE "NOT GENERATING THE REGISTRATION MESSAGE WHEN FLOW OR FREQUENCY ALONE CHANGE" RECITED IN CLAIM 10.

Initially, please see Applicants' statements set out in the Amendment filed June 13, 2008 as reflected by the Applicants' remarks beginning on page 7 with regard to the Rejections under 35 U.S.C. §102. Claim 1 is representative and recites:

1. A method of triggering registration of a mobile station in a wireless network supporting broadcast multicast services, comprising:

triggering generation of a registration message when flow and frequency both change from a first frequency to a second frequency not known to the network from first flow identifier information previously registered by the mobile station with the network;
and

not triggering generation of a registration message when flow or frequency alone change.

The Examiner applies Sinnarajah to teach the negative triggering limitation of claim 1, "not triggering generation of a registration message when flow or frequency alone change." In the Office Action, the Examiner relies on paragraphs [0072] – [0075] discloses this negative triggering limitation.

Applicants respectfully submit that Sinnarajah does not teach the recited negative triggering element. Nowhere does Sinnarajah disclose any scenario addressing “when flow or frequency alone change.” To the contrary, on page 3 of the Office Action, the last bullet point, the Examiner summarizes paragraphs [0072] – [0075] of Sinnarajah and clearly states “Thus Sinnarajah’s registration is triggered **when at least two conditions** [time along with frequency or time along with flow] **change** and thus not register when frequency or flow alone change.” Claim 1 requires that to trigger the generation of a registration message “flow and frequency **both** change” and that if “flow or frequency **alone** change” generation of a registration message is not triggered. The Examiner admits that, where Sinnarajah requires two conditions to trigger registration, one of the conditions is **time**. Therefore Sinnarajah does not disclose **both** flow and frequency change with the additional limitation that no registration message is triggered when frequency or flow **alone** change.

Applicants respectfully submit that the claims are not yet ready for appeal, because, relying on Sinnarajah, the Examiner has yet to show that generation of a registration message is triggered “flow and frequency both change” and is not triggered when “flow or frequency alone change,” as required by claim 1.

Because Sinnarajah fails to teach or suggest each and every element of claim 1, Sinnarajah cannot anticipate or render obvious claim 1. Claims 5 and 10 are allowable at least for reciting the same negative triggering element of claim 1. Claims 2-4, 7-9 and 11-13 are patentable at least by virtue of their dependency from claims 1, 5 or 10. Applicants respectfully request the Board to allow the present application, or at least

reopen prosecution in connection with this application and instruct the Examiner to withdraw the current rejection under 35 U.S.C. § 102(e) to claims 1-5 and 7-13.

II. OZ DOES NOT DISCLOSE "NOT TRIGGERING GENERATION OF A REGISTRATION MESSAGE WHEN FLOW OR FREQUENCY ALONE CHANGE" RECITED IN CLAIM 1.

The Examiner makes a similar two condition argument in regard to Oz as that made with regard to Sinnarajah. On page 7 of the Office Action, the Examiner states "the registration occurs when both frequency and TV channel occurs, C12 L5-13 and L35-41." Applicants assume the Examiner meant frequency and TV channel *change*. As discussed above with regard to Sinnarajah, Oz discloses two conditions changing, and therefore, does not disclose or suggest "not triggering generation of a registration message when flow or frequency alone change," as recited in claim 1. Because Oz fails to teach or suggest each and every element of claim 1, Oz cannot anticipate or render obvious claim 1. Applicants respectfully request the Board to allow the present application, or at least reopen prosecution in connection with this application and instruct the Examiner to withdraw the current rejection under 35 U.S.C. § 102(e) to claim 1.

CONCLUSION

In view of the above, Applicants respectfully request that the Board consider and reverse the current rejections and either allow the present application or reopen prosecution in connection with the present application. Should there be any outstanding matters that need to be resolved in the present application, the Board is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

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